

### **REMARKS**

This Response is in reply to the Office Action mailed on January 13, 2006. Applicant thanks Examiner for the courtesies extended during the telephone interview conducted between applicant's attorney of record and the Examiner on April 28, 2006. Claims 1 and 3-12 are pending. Claims 1, 3, 5, and 7 have been amended herein and claims 8-12 are newly added. Claim 2 was cancelled. No new matter has been added. Entry and consideration of the amendments and following remarks is respectfully requested.

### **AMENDMENTS TO THE CLAIMS**

Claim 1 was amended to include the limitation of claim 2, cancelled herein. Claim 3 was amended to depend from claim 1. Claims 5 and 7 were amended to remove terms such as "preferably" along with the narrower ranges that accompanied the terms. These ranges were included in newly added claims 8-12. Accordingly, no new matter was added.

### **REJECTIONS UNDER 35 U.S.C. § 102(b) AND § 103(a)**

Claims 1 and 4 stand rejected under 35 U.S.C. § 102(b) as anticipated by Martin (U.S. Patent No. 4,859,183). Claims 2, 3, 5, and 7 stand rejected under 35 U.S.C. § 103(a) as obvious over Martin. The rejections are respectfully traversed as Martin neither discloses nor suggests the claimed invention.

Independent claim 1 recites a root canal instrument that has a gripping end that is substantially continuous, has a coefficient of friction of at least 0.4, and is recoverably deformable between fingers. The substantially continuous outer surface of the gripping end insures that there are no protrusions, such as ribs, on the handle. Protrusions increase the stress

on the fingers and can cause pain when a user squeezes the handle with his or her fingertips. Furthermore, protrusions harbor bacteria and make it more difficult to properly sterilize the tool. The substantially continuous surface of the claimed invention eliminates the uncomfortable and unsanitary protrusions. As discussed with the Examiner during the telephone interview of April 28, 2006, it is clear from the specification that the term substantially continuous is not referring to the porosity of the material, but rather to actual protrusions from the handle (page 4 of the specification, lines 8-12).

Furthermore, part of the novelty of the claimed invention lies in that it does not employ protrusions to prevent the fingers from slipping. The coefficient of friction recited in independent claim 1 provides a handle with a grip that has sufficient anti-slip properties so that protrusions are not necessary, and, in fact, they are disadvantageous. Claim 1 requires that the coefficient of friction be greater than 0.4 regardless of the type of material used for the gripping layer. The high coefficient of friction prevents the handle from slipping out of the user's fingers.

In contrast to the claimed invention, Martin discloses a handle with transverse grooves 18. The handle of Martin is, therefore, not substantially continuous. In fact, Martin teaches away from the claimed invention by requiring grooves. The handle of Martin would cause point-form stress to the finger's of a user and would harbor bacteria in the grooves. Clearly, Martin fails to teach the claimed invention and consequently does not have the benefits of the present invention.

Furthermore, Martin does not disclose the coefficient of friction recited in independent claim 1. Martin relied on the grooves to provide anti-slip properties and did not rely on the coefficient of friction. Since the grooves provide the anti-slip properties in Martin, a slipperier

material could have been used. It should also be noted that the mere mention of silicone by Martin does not teach the claimed properties. Although the specification lists silicone rubber as a material that may be used in carrying out the claimed invention, this does not mean that silicone rubber itself is the invention. The silicone must still have the other properties of the claimed invention. In Martin, a silicone could have been used with a coefficient of friction outside the claimed range.

Similarly, Martin does not disclose that the hardness of at least the material used in the outer surface of the gripping end as well as the thickness of this material layer are so chosen that the shape of the gripping end is recoverably deformable between fingers. In fact, Martin teaches that many suitable materials would work, including metal which certainly is not recoverably deformable (col. 3, line 1). It is apparent that Martin is not concerned with the softness of the handle. Additionally, the mere mention of silicone does not teach that the gripping end is recoverably deformable. If silicone is used, it, *in conjunction with the other materials of the gripping end*, must be recoverably deformable between the fingers. Silicone used on the outer surface of a handle may not be recoverably deformable if the material underneath it is too hard and if the silicone layer is too thin. Accordingly, the mention of silicone is not enough to teach the claimed invention.

Finally, Examiner argued that Martin discloses a dual layer handle (page 2 of the Outstanding Office Action). Examiner relied on Figure 3 to show this feature. Applicant respectfully requests that Examiner review Figure 3 again to see that no dual layer handle is shown. The cross-section is taken along the line 3-3 in Figure 1. Line 3-3 runs between two cylindrical portions 16 cutting a groove 18 in half. The angled lines in Figure 3 show the single

layer cross-section of the handle. What appeared to the Examiner as a second layer is actually the outer side wall of one of the cylindrical portions 16. Accordingly, Martin does not disclose a dual layer handle.

In view of the above, it is respectfully submitted that Martin does not teach or suggest the invention of independent claim 1. Accordingly, claim 1 is patentable. By reason of their dependency from claim 1, either directly or indirectly, claims 3-12 are also patentable. Examiner is respectfully requested to withdraw the rejections of the claims.


**CONCLUSION**

In view of the amendments to the claims made herein and the arguments presented above, it is submitted that the Examiner's rejections have been overcome and should be withdrawn. The application should now be in condition for allowance.

Should any changes to the claims and/or specification be deemed necessary to place the application in condition for allowance, the Examiner is respectfully requested to contact the undersigned to discuss the same.

This Response is being filed with a petition for a two-month extension of time and the required fee. In the event that any other extensions and/or fees are required for the entry of this Amendment, the Patent and Trademark Office is specifically authorized to charge such fee to Deposit Account No. 23-2820 in the name of Wolf, Block, Schorr & Solis-Cohen LLP. An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,  
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